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EXAMINER

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 49

Application Number: 08/873,974
Filing Date: June 12, 1997
Appellant(s): SCROGGIE ET AL.

MAILED

MAR 11 2003

Richard A. Neifeld
For Appellant

GROUP 3600

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/23/02.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Whether one or more of claims 50, 51, 54, 60, 61, 70, 71, 80 and 81 are anticipated under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211) and whether one or more of claims 52-53, 55-59, 62, 72 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Narasimhan et al (US Patent 6,237,145 B1).

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 50-89 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,918,211	Sloane	6-1999
6,237,145 B1	Narasimhan et al	5-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 50, 51, 60, 61, 70, 71, 80, 81 are rejected under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211).

As per claims 50, 60, 70, 80, Sloane discloses:

a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer.../storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer.../means for storing...(Col. 7, lines 22-26);

at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network...(Col. 7, lines 13-17, where the retailer computer/controller of Sloane is analogous to the cooperative network site and the sender of Sloane is analogous to the manufacturer);

a consumer computer coupled to one of said manufacturer network site...(Fig.'s 4 and 5 where the consumer computer is represented as the portable bar code scanning device of Sloane);

wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request...(Col. 7, line 65-Col. 8, line 7, Col. 8, lines 44-48).

As per claims 51, 61, 71, 81, the following is inherent with Sloane because Sloane teaches that the manufacturer/retailer incentives are stored by the retailer computer/controller in Col. 7, lines 22-26. In addition, Sloane discloses that the computer/controller contains a database which stores information in Col. 8, lines 50-54:

wherein said cooperative network site is configured to store at least one of said manufacturer incentives and retailer incentives in a database.../storing at said cooperative network site at least one of said manufacturer incentives and retailer incentives in a database coupled thereto.../means for storing...

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

Claims 52-59, 62-69, 72-79, and 82-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Narasimhan, et al (US Patent 6,237,145 B1).

As per claim 52, 62, 72, 82, Sloane discloses:

Said consumer transmits incentive selection data selected from said incentive data to said cooperative network.../transmitting by said consumer incentive selection data.../means for transmitting...(Col. 7, lines 4-13, where the incentive selection data is represented by the consumer promotion or message offered with the item on sale);

Said cooperative network site transmits incentives corresponding to said selection data to said consumer.../transmitting from said cooperative network site incentives corresponding to said selection data .../means for transmitting...(Col. 8, lines 3-7, where the incentives are represented by the discount or promotion).

Sloane fails to disclose the following, however Narasimhan, et al discloses:

Wherein, in response to a query from said consumer made over said communication network from said manufacturer network site, said cooperative network site transmits a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer.../transmitting from said cooperative network site a geographically limited list of retailers.../means for transmitting...(Col. 4, lines 62-65, Col. 8, lines 4-13);

It would have been obvious to one of ordinary skill in the art for a geographically limited list of retailers honoring incentives and corresponding incentive data to a consumer with the motivation of giving the consumer the ability to customize and control his or her purchase preferences by location.

As per claims 53, 63, 73 and 83, neither Sloane or Narasimhan, et al disclose:

Wherein said cooperative network site transmits said geographically limited list of retailers based on a postal code...

Official notice is taken that it is old and well known in the art to have a geographical list sorted by postal code. It would have been obvious to one of ordinary skill in the art to sort a geographical list by postal code in order to specifically define the closest locations in which incentive data can be sent.

As per claim 54, 64, 74 and 84 Sloane discloses:

Transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site... (Col. 7, lines 4-13, where the incentive selection data is represented by the consumer promotion or message offered with the item on sale);

Transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site... (Col. 8, lines 3-7, where the incentives are represented by discount or promotion).

Sloane fails to disclose, however Narasimahan et al discloses:

Transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site... (Col. 8, lines 4-19, where the query is represented by the extended search for a specific type of promotion which is also defined as an extended search query in Col. 8, lines 41-47).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to transmit incentive data in response to a query from a consumer with the motivation of giving the consumer more of a reason to participate in the

incentive program since he/she would be more likely to receive an incentive for a product in which he/she is interested.

As per claims 55, 65, 75, 85, Sloane discloses:

Said consumer transmits incentive selection data.../transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site.../means for transmitting by said consumer incentive selection data...(Col. 7, lines 4-13, where the incentive selection data is represented by the consumer promotion or message offered with the item on sale);

Said cooperative network site transmits incentives corresponding to said selection data.../transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.../means for transmitting from said cooperative network site incentives corresponding to said selection data...(Col. 8, lines 3-7, where the incentives are represented by the discount or promotion).

Sloane fails to teach the following, however Narasimhan et al discloses:

Wherein, in response to a query from said consumer made over said communication network from said retailer network site, said cooperative network site transmits a consumer personal page.../transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site.../means for transmitting from said cooperative network site a consumer personal page including incentive data...(Col. 4, lines 41-45, where the personal page is represented by the presentation of the promotions in a manner customized to a particular user's interests via the internet by way of a navigator).

It would have been obvious to one of ordinary skill in the art to transmit a consumer personal page with the motivation of offering the consumer with a page specifically customized for his or her purchasing purposes.

As per claim 56, 66, 76 and 86, Sloane discloses:

Said consumer transmits incentive selection data.../transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site.../means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site...(Col. 7, lines 4-13, where the incentive selection data is represented by the consumer promotion or message offered with the item on sale);

Said cooperative network site transmits incentives corresponding to said selection data.../transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.../means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site...(Col. 8, lines 3-7, where the incentives are represented by the discount or promotion).

Sloane fails to teach the following, however Narasimhan et al discloses:

Wherein, in response to said consumer transmitting an identification code over said communication network from said retailer network site, said cooperative network site transmits incentive data for manufacturer offers available.../transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of

said consumer associated with said identification code.../means for transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code...(Col. 6, lines 50-59, Col. 4, lines 41-45, Col. 9, lines 5-12).

It would have been obvious to one of ordinary skill in the art to transmit an identification code over the communication network with the motivation of transmitting the incentive to a specific identified consumer.

As per claim 57, 67, 77 and 87, Sloane discloses:

Wherein said incentive data is based on said consumer specific data comprising a shopping history of said consumer...(Col. 8, lines 50-63).

As per claim 58, 68, 78 and 88, Sloane fails to disclose, however Narasimhan et al discloses:

Wherein said incentive data is based on said consumer specific data comprising demographic data...(Col. 9, lines 5-16).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to base incentive data on demographic data with the motivation of offering incentives to customers based on the size, density and distribution of a population of consumers.

As per claim 59, 69, 79 and 89, Sloane fails to disclose, however Narasimhan et al discloses:

Wherein said incentive data is based on said consumer specific data comprising customer profile data...(Col. 1, lines 15-20).

It would have been obvious to one of ordinary skill in the art for incentive data to be based on customer profile data with the motivation of offering customers incentives with relation to specific customer qualities:

(11) *Response to Argument*

Appellant argues that in the outstanding office action, the examiner rejects claims 50, 51, 60, 61, 70, 71, 80 and 81 under 35 USC 102(e) as being clearly anticipated by Sloane (US Patent 5,918,211) and that claims 52, 53, 55-59, 62, 72 and 82 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane in view of Narasimhan et al (US Patent 6,237,145). Appellant feels that the Sloane and Narasimhan et al combination does not suggest any claim. Specifically, appellant argues that Sloane is directed to a method, bar code apparatus and system for providing incentives to consumers at a point-of-purchase (POP) in a retail store and fails to disclose or suggest distributing product incentives to consumers over a communication network even though appellant admits that Sloane does disclose processing incentives between a retailer (or product manufacturer) and a retailer computer/controller over a communication network. First, the examiner did not reject claims 50, 51, 60, 61, 70, 71, 80 and 81 under 35 USC 102 (e) as being clearly anticipated by Sloane, but did reject them as only being anticipated by Sloane. In addition, Sloane does disclose distributing product incentives over a communication network in Col. 7, lines 4-26. In this passage, Sloane discloses that consumer

promotions (analogous to product incentives) are distributed via communication line (analogous to communication network), which can be a direct modem, a LAN or a WAN. These consumer promotions are transmitted from the retailer and distributed to the consumer. The retailer computer offers these promotions to the consumer via communication line upon selection by the consumer. The offering of these promotions represents the actual distribution of the product incentives. For example, the Sloane patent shows that when a consumer selects a product required for a promotion, the discount is automatically subtracted from the price of the item and the purchase is recorded at the discounted price (See Col. 8, lines 40-48).

Also, with respect to Sloane, appellant argues that Sloane merely shows that a manufacturer can transmit promotional information to a retailer and does not show a cooperative network site in addition to a manufacturer computer system and a retailer computer system. Appellant also argues that in Col. 7, lines 22-26, all Sloane discloses is that the manufacturer may download data to the retailer computer system, unrelated to any other event, which, according to appellant teaches away from the claimed concept of an interactive system with operates "in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site". However the cooperative network site is represented in Col. 7, lines 15-22 by the on-line computer network (LAN OR WAN). This computer network acts as the cooperative network site since this addition allows the manufacturer computer system to communicate with the retailer computer system. Also, Sloane shows that a consumer request can be incorporated into the system in Col. 2, lines 17-

21. In this case, the consumer requests a promotion/coupon through an on-line computer network. Also col. 7, lines 4-15 show that when a consumer selects an item (analogous to the consumer request), the sender of the promotional information sends the information to the retailer computer. In this case, the consumer's request triggers the transmittal of the promotional information from the manufacturer's system to the retailer's system.

Next, appellant argues that the use of the Narasimhan et al (US 6,237,145) reference in combination with Sloane (US 5,918,211) does not suggest any claim. Appellant argues Sloane et al as discussed above in the preceding paragraph. In addition, Appellant argues that Narasimhan et al teaches away from the claimed invention because Narasimhan et al teaches that the user's input goes into the retailers computer system instead of via the user's computer system in order to receive an incentive. However, Narasimhan et al discloses that a user's input goes into the personal computer or PC in Col. 3, lines 10-17. This passage indicates that a user at a user PC can choose from a plurality of promotions, where each promotion includes an offer from a vendor in connection with the product or service. In this case, the user's input is going into the user's PC.

Appellant also argues that Narasimhan et al fails to disclose a cooperative network site or transmitting a consumer personal page. However, in combination with Sloane, the cooperative network site is disclosed as described above in the preceding paragraphs. In addition, Narasimhan et al discloses that the user employs a "navigator" to browse the promotions based on user-defined search criteria, and that the

promotions are presented to the user in a manner that is customized to the user's or consumer's particular interests in Col. 4, lines 41-45. In this case, the customized presentation of the promotions according to a user's particular interests represents a consumer personal page since the consumer is utilizing a "navigator" which corresponds to the Internet where personal pages are presented.

Appellant also argues the official notice taken by the examiner and recommends that the examiner supply evidence in support of the official notice. However, it is not required that an examiner provide evidence during the appeal stage of the application.

Appellant also argues that the combination of the Sloane and Narasimhan et al is vague and that there is no substantial evidence supporting the examiner's rationale for the obviousness rejections. However, it would have been obvious at the time of the applicant's invention to combine these two references since they both disclose offering promotional discounts/coupons to consumers based on the selection of promotional products or informational records.

Finally, the appellant argues that the 12 limitations identified that the examiner asserts are not supported by the specification are supported by the specification. Upon review of the appellant's citing to the original disclosure, the examiner has withdrawn the 35 U.S.C. 112 rejection to claims 63-66, 73-76 and 83-86 and all claims that depend from them (claims 67-69, 77-79 and 87-89).

For the above reasons, it is believed that the rejections should be sustained.

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Art Unit: 3623

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Respectfully submitted,



A. R. B.
March 6, 2003

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